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10/598,036	08/16/2006	Yuichi Kobayakawa	P30431	9405
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EXAMINER LINDSEY, MATTHEW S				
ART UNIT		PAPER NUMBER		
4152				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
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# Office Action Summary

**Application No.**

10/598,036

**Applicant(s)**

KOBAYAKAWA ET AL.

**Examiner**

MATTHEW S. LINDSEY

**Art Unit**

4152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/85/08)
- Paper No(s)/Mail Date 16 November 2006
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-20 are pending in this application.

#### ***Information Disclosure Statement***

2. The information disclosure statement filed 11/16/2006 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the not all the information referred to has been considered.

Non-patent literature document No. 1 (Suzuki et al.) has not been included or could not be located by examiner because it is in a foreign language; this reference has not been considered.

#### ***Specification***

3. The disclosure is objected to because of the following informalities:
4. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (Page 1, lines 22-23). Applicant is required to

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delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

### ***Claim Objections***

5. Claim 13 is objected to because of the following informalities: "according to the selection operation" (Claim 13, line 3). There is insufficient antecedent basis for "the selection operation". For the purposes of examination it will be treated as "a selection operation".

6. Claim 16 is objected to because of the following informalities: "said switching step" (Claim 16, line 3). There is insufficient antecedent basis for "said switching step". For the purposes of examination it will be treated as "a switching step".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. **Claim 19 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

9. With respect to Claim 19, the claim lacks the necessary physical articles or objects to constitute a machine or manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. The limitations are to a set of functions executed by a program, and as such constitute software per se.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. **Claims 1-8, 11, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Robertson et al. (Dual Device User Interface Design: PDAs and Interactive Television, April 13, 1996)**

12. With respect to Claim 1, Robertson discloses: "An inter-apparatus collaboration method executed between a first apparatus, second apparatus and third apparatus (pg 79, right col., lines 29-31 where a first apparatus is a PDA, a second apparatus is a cable television and a third apparatus is a computer on a network), comprising: a direct communication step of carrying out direct communication between said first apparatus and said second apparatus (pg 80, The PDA-ITV Application, left col., lines 16-17 and right col., lines 1-3); a delivery step of delivering information used for processing at said first apparatus and said second apparatus from said third apparatus when communication is carried out in said direct communication step (pg 80, The PDA-ITV Application, left col., lines 16-17 and right col., lines 1-10, where the third apparatus is the server which communicates with the set top box, second apparatus, and data is displayed on the TV, second apparatus, and/or transmitted back to the PDA, first apparatus); and an execution step of executing processing based on the information delivered in said delivery step at said first apparatus and said second apparatus (pg 80, The PDA-ITV Application, left col., lines 16-17 and right col., lines 1-10), wherein an output of said first apparatus and an output of said second apparatus through the processing executed in said execution step have different contents (pg 81, House Information Browsing, lines 1-5, and pg 82, Figure 2)".

13. With respect to Claim 2, Robertson discloses: "The inter-apparatus collaboration method according to claim 1, further comprising an output step of carrying out predetermined output processing at said first apparatus (pg 82, Figure 2 and caption),

wherein said execution step comprises a switching step of switching contents of the output by the output processing carried out in said output step based on the information delivered in said delivery step (pg 82 Figure 2 and caption)".

14. With respect to Claim 3, Robertson discloses: "The inter-apparatus collaboration method according to claim 2, further comprising an identification information transmission step of transmitting identification information of at least one of said first apparatus and said second apparatus to said third apparatus (pg 80, right col., lines 2-10), wherein said delivery step delivers information based on the identification information transmitted in said identification information transmission step (pg 82, Figure 2 and caption, where identification information must be used to differentiate between the output meant for the TV and the output meant for the PDA)".

15. With respect to Claim 4, Robertson discloses: "The inter-apparatus collaboration method according to claim 2, wherein: said direct communication step reports the identification information of said first apparatus from said first apparatus to said second apparatus (pg 80, right col., lines 2-10); the method further comprises an identification information transmission step of transmitting the identification information reported in said direct communication step from said second apparatus to said third apparatus (pg 80, right col., lines 2-10); and said delivery step delivers information based on the identification information transmitted in said identification information transmission step

(pg 82, Figure 2 and caption, where identification information must be used to differentiate between the output meant for the TV and the output meant for the PDA)".

16. With respect to Claim 5, Robertson discloses: "The inter-apparatus collaboration method according to claim 2 wherein: one of said first apparatus and said second apparatus comprises a non-contact type information medium (pg 80, right col., lines 2-3); and in said direct communication step, the other of said first apparatus and said second apparatus reads said non-contact type information medium (pg 80, right col., lines 2-3)".

17. With respect to Claim 6, Robertson discloses: "The inter-apparatus collaboration method according to claim 5, wherein: said one of said first apparatus and said second apparatus further comprises a body section (Figure 1, the TV); and said non-contact information medium is provided apart from said body section (pg 80, right col., lines 1-10, where the set top box is away from said body)".

18. With respect to Claim 7, Robertson discloses: "The inter-apparatus collaboration method according to claim 2, further comprising a function information transmission step of transmitting function information of at least one of said first apparatus and said second apparatus to said third apparatus (pg 80, Right col., lines 2-10 and pg 80, Left col., lines 10-13 where combinations of different devices have different input and output functions that must be known to the system to be utilized), wherein said delivery step



delivers information based on the function information transmitted in said function information transmission step (pg 82, Figure 2 and caption, where function information must be used to determine what each device is capable of displaying)".

19. With respect to Claim 8, Robertson discloses: "The inter-apparatus collaboration method according to claim 2, wherein: said direct communication step reports the function information of said first apparatus from said first apparatus to said second apparatus (pg 80, Right col., lines 2-10 and pg 80, Left col., lines 10-13 where combinations of different devices have different input and output functions that must be known to the system to be utilized); the method further comprises a function information transmission step of transmitting the identification information reported in said direct communication step from said second apparatus to said third apparatus (pg 80, Right col., lines 2-10); and said delivery step delivers information based on the identification information transmitted in said identification information transmission step (pg 82, Figure 2 and caption, where function information must be used to determine what each device is capable of displaying)".

20. With respect to Claim 11, Robertson discloses: "The inter-apparatus collaboration method according to claim 2, wherein: the information delivered in said delivery step comprises operation information on a processing operation at said first apparatus (pg 82, Figure 2 and caption) and control information for controlling a processing operation at said first apparatus (pg 82, Figure 2 and caption); and said

execution step carries out the processing based on said operation information at said first apparatus (pg 82, Figure 2 and caption, where selecting a house on the PDA will display its details) and the processing based on said control information at said second apparatus (pg 82, Figure 2 and caption, where selecting a house on the PDA will display a picture of the house on the TV)".

21. With respect to Claim 18, Robertson discloses: "An inter-apparatus collaboration control system (pg 79, right col., lines 29-31) comprising: a first apparatus and a second apparatus (pg 79, right col., lines 29-31, where the first apparatus is a PDA and a second apparatus is a cable television) that directly communicate with each other (pg 80, The PDA-ITV Application, left col., lines 16-17 and right col., lines 1-3); and a third apparatus that delivers information used for processing at said first apparatus and said second apparatus when said first apparatus and said second apparatus carry out communication (pg 80, The PDA-ITV Application, left col., lines 16-17 and right col., lines 1-10, where the third apparatus is the server which communicates with the set top box, second apparatus, and data is displayed on the TV, second apparatus, and/or transmitted back to the PDA, first apparatus), wherein: said first apparatus and said second apparatus execute processing based on the information delivered from said third apparatus respectively (pg 80, right col., lines 1-10); and an output of the processing executed at said first apparatus and an output of the processing executed at said second apparatus have different contents (pg 81, House Information Browsing, lines 1-5, and pg 82, Figure 2 and caption)".

22. With respect to Claim 19, Robertson discloses: "An inter-apparatus collaboration control program for an inter-apparatus collaboration control system (pg 79, right col., lines 29-31) comprising a first apparatus, second apparatus and third apparatus, (pg 79, Right col., lines 29-31 where a first apparatus is a PDA, a second apparatus is a cable television and a third apparatus is a computer on a network) said inter-apparatus collaboration control program being for realizing: a direct communication function that carries out direct communication between said first apparatus and said second apparatus (pg 80, The PDA-ITV Application, left col., lines 16-17 and right col., lines 1-3, where the first apparatus is a PDA and the second apparatus is the set top box); a delivery function that delivers information used for processing at said first apparatus and said second apparatus from said third apparatus when communication by said direct communication function is carried out (pg 80, The PDA-ITV Application, left col., lines 16-17 and right col., lines 1-10, where the third apparatus is the server which communicates with the set top box, second apparatus, and data is displayed on the TV, second apparatus, and/or transmitted back to the PDA, first apparatus); and an execution function that executes the processing based on the information delivered from said delivery function at said first apparatus and said second apparatus (pg 80, right col., lines 1-10), wherein an output of said first apparatus through the processing executed by said execution function and an output of said second apparatus have different contents (pg 81, House Information Browsing, lines 1-5, and pg 82, Figure 2 and caption)".

23. With respect to Claim 20, Robertson discloses: A terminal apparatus (pg 79, right col., lines 29-31, a PDA) comprising: a direct communication section that carries out direct communication with another terminal apparatus (pg 80, The PDA-ITV Application, left col., lines 16-17 and right col., lines 1-3); an acquisition section that acquires information delivered from a server apparatus when communication is carried out by said direct communication section (pg 80, right col., lines 1-10); and an execution section that executes processing based on the information acquired by said acquisition section (pg 80, right col., lines 1-10), wherein an output of the processing executed by said execution section and an output of said another terminal apparatus through the processing based on the information delivered from said server apparatus to said another terminal apparatus have different contents (pg 81, House Information Browsing, lines 1-5, and pg 82, Figure 2 and caption)".

***Claim Rejections - 35 USC § 103***

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**25. Claims 9, 10, and 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson, as applied to Claim 2 above, in view of Atkinson (Pub No: US 20010053996).**

26. With respect to Claim 9, Robertson discloses: "The inter-apparatus collaboration method according to claim 2, wherein: the method further comprises an information selection step of selecting at least part of the information delivered in said delivery step based on said user information (pg 82, Figure 2, and caption, where when a user selects a house on the PDA, the details of the house are provided); and said execution step executes the processing based on at least part of said information selected in said information selection step at said second apparatus (pg 82, Figure 2, and caption, where when a user selects a house on the PDA, the image of the house is displayed on the TV)". Robertson does not disclose: "said second apparatus stores user information".

However, Atkinson discloses: "said second apparatus stores user information ([0026], lines 16-19, where first device is a user communication device, [0025] lines 8-11, and second device is a local media manager)"

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the multi device interface of Robertson with the teachings of Atkinson to include storing user data at a central location. Motivation to combine these references comes from Atkinson where "information about the demographics of users in a public space is a valuable variable to track, including raw numbers of people but also

more refined demographic data about the population" ([0026], lines 19-23). Therefore by combining the multi device interface of Robertson with storing user data at a central location of Atkinson, one can collect valuable demographic data about users who visit a particular place.

27. With respect to Claim 10, Robertson discloses: "The inter-apparatus collaboration method according to claim 2, wherein: the method further comprises an information selection step of selecting at least part of the information delivered in said delivery step based on said user information (pg 82, Figure 2, and caption, where when a user selects a house on the PDA, the details of the house are provided); and said execution step executes the processing based on at least part of said information selected in said information selection step at said first apparatus and said second apparatus (pg 82, Figure 2, and caption, where when a user selects a house on the PDA, the image of the house is displayed on the TV, and the details of the house are displayed on the PDA)". Robertson does not disclose: "said second apparatus stores user information".

However, Atkinson discloses: "said second apparatus stores user information ([0026], lines 16-19, where first device is a user communication device, [0025] lines 8-11, and second device is a local media manager)"

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the multi device interface of Robertson with the teachings of Atkinson to include storing user data at a central location. Motivation to combine these

references comes from Atkinson where "information about the demographics of users in a public space is a valuable variable to track, including raw numbers of people but also more refined demographic data about the population" ([0026], lines 19-23). Therefore by combining the multi device interface of Robertson with storing user data at a central location of Atkinson, one can collect valuable demographic data about users who visit a particular place.

28. With respect to Claim 12, Robertson discloses: "The inter-apparatus collaboration method according to claim 2, wherein: said direct communication step reports additional information necessary to obtain an output of processing executed in said execution step (pg 82, Figure 2 and caption where user selects a house on the PDA and this is communicated with the TV to coordinate their displays)", but does not disclose: "and the method further comprises a storing step of storing additional information reported in said direct communication step in said second apparatus".

However, Atkinson discloses: "and the method further comprises a storing step of storing additional information reported in said direct communication step in said second apparatus ([0026], lines 16-19, where first device is a user communication device, [0025] lines 8-11, and second device is a local media manager)"

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the multi device interface of Robertson with the teachings of Atkinson to include storing user data at a central location. Motivation to combine these references comes from Atkinson where "information about the demographics of users in

a public space is a valuable variable to track, including raw numbers of people but also more refined demographic data about the population" ([0026], lines 19-23). Therefore by combining the multi device interface of Robertson with storing user data at a central location of Atkinson, one can collect valuable demographic data about users who visit a particular place.

29. With respect to Claim 13, the combination of Robertson and Atkinson disclose: "The inter-apparatus collaboration method according to claim 12, wherein said storing step determines whether additional information is stored or not according to the selection operation at said second apparatus (Atkinson, [0026], lines 16-19, specifically, "sometimes", implicitly meaning a selection of data to be stored)"

30. With respect to Claim 14, the combination of Robertson and Atkinson disclose: "The inter-apparatus collaboration method according to claim 12, further comprising a re-outputting step of re-outputting the output of said second apparatus (Atkinson, [0026], lines 1-3) through the processing executed in said execution step using the additional information stored in said storing step (Atkinson, [0026], lines 16-19, where according to [0026], lines 1-3, transient state variables are used to select the output of media elements and user data can make up part of the transient state variables)".

31. With respect to Claim 15, the combination of Robertson and Atkinson disclose: "The inter-apparatus collaboration method according to claim 14, further comprising: a



display step of displaying the additional information stored in said storing step in a comparable manner (Atkinson, [0026], lines 16-19, where according to [0026], lines 1-3, transient state variables are used to select the output of media elements and user data can make up part of the transient state variables); and a display information selection step of selecting at least part of the additional information displayed in said display step (Atkinson, [0026], lines 16-19, specifically, "sometimes", implicitly meaning a selection of data to be stored), wherein said re-outputting step uses at least part of said additional information selected in said display information selection step (Atkinson, [0026], lines 16-19, where according to [0026], lines 1-3, transient state variables are used to select the output of media elements and user data can make up part of the transient state variables)".

32. With respect to Claim 16, the combination of Robertson and Atkinson disclose: "The inter-apparatus collaboration method according to claim 14, wherein said re-outputting step comprises a control step of controlling switching in said switching step (Atkinson, [0026], lines 1-3)".

33. With respect to Claim 17, the combination of Robertson and Atkinson disclose: "The inter-apparatus collaboration method according to claim 12, further comprising a discrepancy reporting step of reporting, when there is a discrepancy between contents of the additional information stored in said storing step and contents of information in said third apparatus, the occurrence of said discrepancy to said second apparatus

(Atkinson, [0037], lines 1-3, where to receive updates there must be a reporting step where the availability of the update is made known to the local media manager, and the third apparatus is an external device)".

### ***Conclusion***

34. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- a. Walker et al. (US 6,754,636) teaches purchasing system using multiple devices
- b. Kunii et al. (US 7,095,402) teaches a user device capable of controlling devices.
- c. Ellis et al. (US 20020174430) teaches an interactive remote control.
- d. Takatori (US 20030033610) teaches recording a program from a remote based on information obtained from the internet.
- e. Dubil et al. (US 20030035074) teaches an interactive remote with a display.
- f. Reisman (US 20030229900) teaches a coordinated multi device interface using device sets.
- g. Robinson et al. (US 20040109087) teaches a method for digital shopping from a remote control using a television with communication to the internet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW S. LINDSEY whose telephone number is (571)270-3811. The examiner can normally be reached on Mon-Thurs 7:30-5, Alternate Fridays 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nabil El-Hady can be reached on (571) 272-3963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MSL  
2/12/2008

/Nabil El-Hady/  
Supervisory Patent Examiner, Art Unit 4152